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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,177	11/27/2000	Frederick W. Ryan JR.	F-211	3933

919 7590 12/30/2004

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EXAMINER
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COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/722,177

Applicant(s)

RYAN, FREDERICK W.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,5,6,17,18,21 and 22 is/are allowed.
- 6) ☒ Claim(s) 3,4,7-16,19,20 and 23-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>see attached</u> . | 6) <input type="checkbox"/> Other: _____  |

1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and

C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.

2. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

3. Claims 3, 4, 7-16, 19, 20 & 23-32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3.1 In regard to claims 3, 4, 7, 8, 11, 12, 15, 16, 19, 20, 23, 24, 27, 28, 31 & 32, since claims 1, 2, 5, 6, 9, 10, 13, 14, 17, 18, 21, 22, 25, 26, 29 & 30, respectively fail to recite a "first print head" and a "second print head" the references to a "first print head" and/or a "second print head" in claims 3, 4, 7, 8, 11, 12, 15, 16, 19, 20, 23, 24, 27, 28, 31 & 32 lacks antecedent basis within the respective base claim. It is noted that claims 1, 2, 5, 6, 9, 10, 13, 14, 17, 18, 21, 22, 25, 26, 29 & 30 recite a "secured print head" and an "unsecured print head".

3.2 In regard to claims 9 & 25, since either the "non-authorization data" or the "content data" that is printed by the "unsecure print head" and the "forensic evidence" printed by the "secure print head" as recited in this claim do not contain "non-authentication data", it is unclear how a document containing "non-authentication data" is printed as recited as the purpose/function of this claim.

3.3 Applicant's inclusion of the process claim 16, into machine/apparatus claim 1/5/6/7 by dependency creates an improper hybrid claim and hence the recited combination of claimed

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subject matter is confusing. This confusion occurs, since it can not be determined from the language of the final combined claim into which one of the statutory classes of invention the combined claim is to be classified as; that is either:

- A) a process, or
- B) a machine, or
- C) a manufacture, or
- D) a composition of matter.

Note ex parte Lyell, 17 USPQ 2nd 1548 (Bd. Pat. App. & Inter. 1990) and MPEP § 2173.05(p).

3.4 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

4. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

4.1 Claims 3, 4, 7-16, 19, 20 & 23-32 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 3, 4, 7-16, 19, 20 & 23-32, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 112 2<sup>nd</sup> paragraph as set forth above.

5. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) in regard to claims 1, 9, 17 & 25 the prior art does not teach or suggest a system/method of printing a postage indicia by using a single printer with a first unsecured print head to print non-authentication or non-verification information and a second secure print head to print the authentication/verification information contained in the postage indicia. Claims 2-8, 10-16, 18-24 & 26-32 are allowable for the same reason.

6. The examiner has cited prior art of interest, for example:

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A) either Wright et al (4,864,618) or Naclerio (5,684,949) or Shah et al (,822,738) disclose that the accounting unit or SMD of a postage metering system must be authenticated to the printing unit of the postage metering system before postage maybe printed.

B) Gilham (5,200,903) disclose the use of a single print head with multiple section to print the address information and postage indicia on an item of mail.

C) the PR Newswire article discloses that the printing of valuable objects includes the use of authentication to authorize the printing.

D) Tuhro (5,635,694) disclose that use of embedded coded information in postage indicia.

E) either Gargiulo et al (EP 0825562 A2 or 5,745,887) disclose that the printer of a postage metering system may be operated in two different manners during the printing of postage.

F) Kara (6,208,980) disclose the use of two individual printers to print multiple postage indicia at the same time.

6.1 The Information Disclosure Statements filed 27 November 2000; 09 March 2001 & 16 September 2002 have been considered and are attached.

7. Claims 9 & 25 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112. Claims 3, 4, 7, 8, 10-16, 19, 20, 23, 24 & 26-32 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 C.F.R. § 1.111(b) and section 707.07(a) of the M.P.E.P.

8. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783.

The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

9.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

9.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

12/23/04



Edward R. Cosimano  
Primary Examiner A.U. 3629